

**REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed November 2, 2004. At the time of the Office Action Claims 1-33 of the present application were pending. Claims 1-33 were rejected by the Final Office Action. In order to advance prosecution of this Application, Applicants amend Claims 1-11, 13-25, and 28-33 and add new Claim 34. Applicants believe that Claims 1-34 are in condition for allowance and respectfully request reconsideration and favorable action in this case.

**Section 103 Rejections**

The Office Action rejects Claims 1-11 and 13-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,453,022 issued to Weinman, Jr. ("*Weinman*") in view of U.S. Patent No. 6,785,560 issued to Chow et al. ("*Chow*"). Applicants respectfully traverse this rejection for the reasons stated below.

Claim 1 recites a method for managing incoming and outgoing calls that includes establishing, over a first phone line of an IP telephone, a first call on a packet switched network, the first call including an outbound packet media stream communicated from the IP telephone. The method also includes detecting that the first call was placed on hold and establishing, over a second phone line of the IP telephone, a second call on the packet switched network. The outbound packet media stream is communicated in the second call, and a first incoming packet media stream from the first call is mixed with a second incoming packet media stream from the second call for presentation to a user of the IP telephone. Claims 14, 21, 28, and 33 recite claim elements similar to Claim 1.

Regarding Claims 1, 14, 21, 28, and 33, *Weinman* discloses a multi-line telephone system 105 designed to be coupled to a central office 120 of a standard public telephony network 125. *See Weinman*, column 3, lines 29-31; figure 1. A standard public telephony network is not operable to transmit packet media streams. *Chow* discloses call processing packets (X.25 packets) being sent between a switch (LDS 104) and a voice access port (VAP 103A and 103B). *See Chow*, column 15, lines 31-63. Neither *Weinman* nor *Chow*, alone or in combination, disclose, teach, or suggest an IP telephone or an outbound packet media stream communicated from the IP telephone.

For at least these reasons, Applicants respectfully submit that Claims 1, 14, 21, 28, and 33 are patentably distinguishable from *Weinman* and *Chow* and request that the rejection of Claims 1, 14, 21, 28, and 33 be withdrawn.

Claims 2-11 and 13 depend from, and incorporate all the limitations of, independent Claim 1. Claims 15-20 depend from, and incorporate all the limitations of, independent Claim 14. Claims 22-27 depend from, and incorporate all the limitations of, independent Claim 21. Claims 29-32 depend from, and incorporate all the limitations of, independent Claim 28. Therefore, Applicants respectfully submit that Claims 2-11, 13, 15-20, 22-27, and 29-32 are patentably distinguishable from the cited art, for example, for the same reasons discussed above with regard to Claims 1, 14, 21, and 28.

The Office Action rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Weinman*. Applicants respectfully traverse this rejection for the reasons stated below.

Claim 12 recites a method for managing incoming and outgoing calls that includes receiving a signal communicated from a second endpoint to a call manager via the network indicating that the first call was placed on hold. *Weinman* discloses that signaling techniques may be used to deliver audio control signals from multi-line telephone 110 to audio controller 215 of switch 220 to adjust amplitude and other audio characteristics of voice signals. See *Weinman*, column 3, lines 46-67 and column 4, lines 32-35. However, *Weinman* does not disclose, teach, or suggest a signal communicated from a second endpoint to a call manager indicating that the first call was placed on hold. For at least these reasons, Applicants respectfully submit that Claim 12 is patentably distinguishable from the *Weinman* reference and request the rejection of Claim 12 be withdrawn.

#### **New Claim**

Applicants have amended the Application to add new claim 34. Applicants respectfully contend that Claim 34 of the present application is fully supported by the specification of the present Application as originally filed. Applicants also respectfully submit that new Claim 34 is patentably distinct from the references cited by the Office Action.

Specifically, Claim 34 is directed to a method for managing incoming and outgoing calls that includes establishing a call on a packet switched network between a first endpoint and a second endpoint. The method also includes detecting that the call was placed on hold by the second endpoint and communicating a signal from the first endpoint to the second endpoint via the network to request that the second endpoint not communicate music or prerecorded messages to the first endpoint while the call is on hold. None of the cited references used in rejecting claims of the present application disclose, teach or suggest, either alone or in combination, communicating a signal to request that a second endpoint not communicate music or prerecorded messages to a first endpoint while the call is on hold. Therefore, Applicants respectfully submit that Claim 34 is patentably distinct from the references cited in the Office Action.

**Conclusions**

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

A check in the amount of \$840.00 is enclosed to cover the fee for the Request for Consideration (RCE) with one additional claim. No other fees are believed to be due, however, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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